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10/611,962	07/03/2003	Hiroshi Inoue	0054-0277P	3566
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BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				SMARTH, GERALD A
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/611,962	INOUE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	GERALD SMARTH	2446	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 August 2009.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6 and 11-15 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-6 and 11-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 03 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____ .                        |

**DETAILED ACTION**

1. It is hereby acknowledged that 10/611962 the following papers have been received and placed of record in the file: Remark date 08/03/09.
2. Claims 1-6, 11-14 are presented for examination. Claim1 is an independent claim. The remaining claims are dependent on claim 1. No claims are being amended.
3. The Rejections are respectfully maintained and reproduced infra for application's convenience.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 11-15 are being rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase (US 2002/0046247A1), Watanabe (6877031) in view of Fujii (2002/0138313),

Regarding claim 1, Iwase teaches a print service system comprising: electronic mail receiving means connected with a network, for receiving an electronic mail including attached image data transmitted from a user through the network; (**Iwase discloses FIG. 6 is a diagram showing an example of the construction of a mail information database; FIG. 7 is a diagram showing an example of the construction of a storage destination specifying database; Paragraph 23 & paragraph 24**)

Print user designation managing means which creates a user ID and a password and a directory for a mail address used by said user, and transmitting said user ID and said password to said mail address; data accumulating means for storing image data received by said electronic mail receiving means for each user ID in said directory; and at least one print means connected with the network, for downloading said image data from said data accumulating means through the network when said user ID and said password are inputted, and printing said image data.” (**This is being anticipated by Iwase. Iwase discloses an electronic mail function is provided as one of the functions provided by the groupware server 2. That is, the groupware server is utilized by a personal computer or work station connected o the network.**” page 2 paragraph 44). (**Iwase also discloses he also claims, in the item of the password, a password given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name; page 4 paragraph 70).** Thus, communication traffic for transmitting the attached file to the portable telephone can be saved and the contents of the attached file can be stored so as to be utilized by

*the user; page 5 paragraph 110). (First, the user inputs a user ID and password by operating the touch panel 43a and operating panel 44 when the attached file stored in the Internet binder 3 is printed by use of the MFP4.; page 6 paragraph 115)*

Iwase does not specifically disclose managing means which creates\_a user ID and a password and a directory for a mail address used by said user, and transmitting said user ID and said password to said mail address;

Watanabe does teach managing means which creates\_a user ID and a password and a directory for a mail address used by said user, (**Fig.3**) (*Wantanabe discloses the WWW application server 15 compares the user ID and the user password having been input with a user ID and a user password registered with and managed by a user information database (not shown). When the user ID and the user password input by the user are valid, a main menu is shown on a screen. When the user selects an electronic mail transmission option from the main menu, the electronic mail transmission service which will be explained below is provided; Column 7 lines 29-36*)

It would be obvious to a person of ordinary skill in the art at the time of the invention to modify the communication system of Iwase to include Watanabe's network photograph service system. One of ordinary skill would have been motivated to make this modification in order to have a system which can transmit images to different destinations in a more time efficient and cost effective manner. This will allow for the user to specifically create his or her unique username and password to be associated with emails being designated for him or her. This will be useful for creating user

security of an individual's personal information content being stored on a server for example. *Watanabe discloses however, it is time-consuming for the user to obtain a recording medium such as a CD-ROM after placing an order for a service to output an image to the recording medium. It is possible to request the service to output images to a recording medium upon requesting image registration. However, in this case, since the image that is desired to be attached to an electronic mail message is not determined at the time of the request for image registration, all the images end up being recorded, which is costly;* Column 1 lines 35-46.

**Fujii teaches transmitting said user ID and said password to said mail address; (Fujii discloses details thereof will be described later, but the live casting server 7 sends various types of information required for receiving the provision of the live distribution, such as the shard password and a reservation ID (described later), to the electronic-mail addresses input in "List of friends" by e-mail. This mail is called notice mail; Paragraph 64 lines 6-9)**

It would be obvious to a person of ordinary skill in the art at the time of the invention to modify the communication system of Iwase, Watanabe's network photograph service system to include Fujii's information processing apparatus, recording medium and program. One of ordinary skill would have been motivated to make this modification in order to have a system gives access to attachment or file to multiple users at a given time. *Fujii discloses conventionally, however, a service has not yet developed in which the contents of chatting performed in the chat space are collectively supplied to the providing source of the contents. In other words, when the providing source of the*

*contents cannot participate in chatting, the providing source cannot check the content of chatting later; Paragraph 6.*

Therefore, it would be obvious to combine Iwase, Watanabe, and Fujii to arrive to the limitations in claim 1.

Regarding Claim 2 Iwase, Watanabe in view of Fujii taught a print service system according to claim 1, as described above. Iwase also teaches further comprising usage guide displaying means connected with the network, for displaying a usage guide including information related to an installation location of said print means.

**(Iwase anticipates this by disclosing Fig.19 is a diagram showing a display example in which the file list received from the Internet binder 3 is displayed on the display section 43. In this case, a file can be selected by touching the file displayed on the display section 43 of the touch panel 43a. In the display example shown in FIG. 19, the above file selection screen is display section 43.” ;page 6 paragraph 120)**

Regarding claim 3 Iwase, Watanabe in view of Fujii taught a print service system according to claim 1, as described above. Iwase further teaches wherein: said print means includes a touch panel; and said user ID and said password are inputted from an input unit composed of a ten-key pad which is displayed on said touch panel. **(Iwase anticipates this by disclosing Fig 14. is a diagram showing a display example when a mail is received from the portable telephone 1 and log-in (access) is made**

*from the portable telephone 1 to the groupware server 2. In the display example of Fg. 14, a user ID input column and a password input column are displayed.” page 5 paragraph 100. Iwase further discloses the display section 43 is a display constructed by a liquid crystal display device containing a touch panel 43a; Page 3 paragraph 63 line 6-8)*

Claim 4 states Iwase, Watanabe in view of Fujii taught a print service system according to claim 1, as disclosed above. Wherein when a mail address of a third party is described in a body of the electronic mail received by said electronic mail receiving means, said user designation managing means transmits a user ID and a password to said mail address of the another user simultaneously with transmitting said user ID and said password to said mail address of the user.” (**Fujii discloses details thereof will be described later, but the live casting server 7 sends various types of information required for receiving the provision of the live distribution, such as the shard password and a reservation ID (described later), to the electronic-mail addresses input in “List of friends” by e-mail. This mail is called notice mail;**  
**Paragraph 64 lines 6-9)**

Regarding claim 5, Iwase, Watanabe in view of Fujii taught a print service system according to claim 4, as described above. Fujii further teaches where in said user ID and said password which are transmitted to said mail address of said third party said are identical to said user ID and said password which are transmitted to said user's mail

address." **(Fujii discloses details thereof will be described later, but the live casting server 7 sends various types of information required for receiving the provision of the live distribution, such as the shard password and a reservation ID (described later), to the electronic-mail addresses input in "List of friends" by e-mail. This mail is called notice mail; Paragraph 64 lines 6-9)**

Regarding claim 6, Iwase, Watanabe in view of Fujii taught a print service system according to claim 4, as described above. Fujii further teaches wherein said user ID and said password which are transmitted to said mail address of said third party are different from said user ID and said password which are transmitted to said user's mail address." **(Fujii discloses details thereof will be described later, but the live casting server 7 sends various types of information required for receiving the provision of the live distribution, such as the shard password and a reservation ID (described later), to the electronic-mail addresses input in "List of friends" by e-mail. This mail is called notice mail; Paragraph 64 lines 6-9)**

Regarding claim 11, Based on the same motivation as in claim 1, Iwase, Watanabe in view of Fujii teaches a print service program for causing a computer connected through a network with a print terminal which performs authentication using a user ID and prints designated image data, to execute: an electronic mail reception step for receiving an electronic mail including attached image data transmitted from a user through the network; **(Iwase discloses in the item of the password, a password**

given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name; page 4 paragraph 70. The MFP4 transits the user ID and password and effects a process for connection to the Internet binder 3. If connection to the Internet binder 3. If connection with the MFP 4 is made, the Internet binder 3 transmits a stored list of files corresponding to the user ID transmitted from the MFP 4 to the MFP 4; Page 6 Paragraph 118) a user ID creation step for creating a user ID for a mail address used by the user; (Fig.3) (*Wantanabe discloses the WWW application server 15 compares the user ID and the user password having been input with a user ID and a user password registered with and managed by a user information database (not shown). When the user ID and the user password input by the user are valid, a main menu is shown on a screen. When the user selects an electronic mail transmission option from the main menu, the electronic mail transmission service which will be explained below is provided; Column 7 lines 29-36*) a user ID transmission step for transmitting the user ID to the mail address; and a data accumulation step for storing the attached image data for each user ID. (Fujii discloses details thereof will be described later, but the live casting server 7 sends various types of information required for receiving the provision of the live distribution, such as the shard password and a reservation ID (described later), to the electronic-mail addresses input in “List of friends” by e-mail. This mail is called notice mail; Paragraph 64 lines 6-9)

Regarding claim 12, Based on the same motivation as in claim 1, Iwase and Watanabe teach a print service program for causing a computer connected through a network with a print terminal which performs authentication using a user ID and prints designated image data, to execute: an electronic mail reception step for receiving an electronic mail including attached image data transmitted from a user through the network; **(Iwase discloses in the item of the password, a password given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name; page 4 paragraph 70.** Iwase further discloses the MFP4 transits the user ID and password and effects a process for connection to the Internet binder 3. If connection to the Internet binder 3. If connection with the MFP 4 is made, the Internet binder 3 transmits a stored list of files corresponding to the user ID transmitted from the MFP 4 to the MFP 4; page 6 paragraph 118) a user ID creation step for creating a user ID for one of the attached image data and the electronic mail; **(Fig.3) (Wantanabe discloses the WWW application server 15 compares the user ID and the user password having been input with a user ID and a user password registered with and managed by a user information database (not shown). When the user ID and the user password input by the user are valid, a main menu is shown on a screen. When the user selects an electronic mail transmission option from the main menu, the electronic mail transmission service which will be explained below is provided; Column 7 lines 29-36)** a user ID transmission step for transmitting the user ID to a mail address used by the user; and a

data accumulation step for storing the attached image data for each user ID. (**Fujii discloses details thereof will be described later, but the live casting server 7 sends various types of information required for receiving the provision of the live distribution, such as the shard password and a reservation ID (described later), to the electronic-mail addresses input in “List of friends” by e-mail. This mail is called notice mail; Paragraph 64 lines 6-9**)

Regarding claim 13, Based on the same motivation as in claim 1, Iwase, Watanabe in view of Fujii teaches a print service program for causing a computer connected through a network with a print terminal which performs authentication using a user ID and prints designated image data, to execute: (**Iwase discloses an electronic mail function is provided as one of the functions provided by the groupware server 2. That is, the groupware server is utilized by a personal computer or work station connected o the network. (page 2 paragraph 44). He also claims, in the item of the password, a password given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name; page 4 paragraph 70).**

an electronic mail reception step for receiving an electronic mail including attached image data transmitted from a user through the network; a judgment step for judging whether or not a mail address of third party described in a body of the electronic mail

received; a user ID creation step for creating a user ID and a password for a mail address used by the user and the mail address of the when it is judged that the mail address of the third party is described in said judgment step; (**Fig.3) (Wantanabe discloses the WWW application server 15 compares the user ID and the user password having been input with a user ID and a user password registered with and managed by a user information database (not shown). When the user ID and the user password input by the user are valid, a main menu is shown on a screen. When the user selects an electronic mail transmission option from the main menu, the electronic mail transmission service which will be explained below is provided; Column 7 lines 29-36**) and a data accumulation step for storing the attached image data for each user ID. a user ID transmission step for transmitting the user ID and the password which are made in the user ID creation step to the mail address of the user and the mail address of the third party; (**Fujii discloses details thereof will be described later, but the live casting server 7 sends various types of information required for receiving the provision of the live distribution, such as the shard password and a reservation ID (described later), to the electronic-mail addresses input in “List of friends” by e-mail. This mail is called notice mail; Paragraph 64 lines 6-9**)

Regarding claim 14, Iwase, Watanabe in view of Fujii taught a print service program according to claim 13, as described above. Fujii further teaches wherein the user ID and the password which are transmitted to the mail address of the other user

are identical to the user ID and the password which are transmitted to the mail address of the user." Transmitting identical user ID and the password to said user mail address and of other user mail address is considered inherent for sending out the same user ID and password to multiple users. (**Fujii discloses details thereof will be described later, but the live casting server 7 sends various types of information required for receiving the provision of the live distribution, such as the shard password and a reservation ID (described later), to the electronic-mail addresses input in "List of friends" by e-mail. This mail is called notice mail; Paragraph 64 lines 6-9**)

Regarding claim 15, Iwase, Watanabe in view of Fujii taught a print service program according to claim 13, as described above. Fujii further teaches wherein the user ID and the password which are transmitted to the mail address of the other user are different from the user ID and the password which are transmitted to the mail address of the user." (**Fujii discloses (in this case, addresses of the users of the personal computers 4-1 to 4-3 have been specified), "Outline," and "Details." An area for inputting a reservation ID (ID supplied in step S25 shown in FIG. 7) is also provided in the display screen; Page 7 Paragraph 158**)

**Response to Argument**

6. Applicant's arguments with respect to claims 9, 17-18 have been considered but are not persuasive.

**Applicant's argument to claims 1-6, 11-15:**

Applicant makes argument that Iwase in view of Watanabe further in view of Fujii fails to teach or suggest creating, in response to receipt of an email with attachment, a user ID and password and transmitting the user ID to the mail address as claimed.

Applicant also makes argument that there is no disclosure or suggestion of transmitting the user ID or password to the mail address from which an electronic mail with attachment was received as claimed.

**In response**

Examiner respectfully disagrees that Iwase in view of Watanabe further in view of Fujii does not teach the limitations in claim 1-3, 11 and 12.

Applicant makes argument that the limitation creating, in response to receipt of an email with attachment, a user ID and password and transmitting the user ID to the mail address is not taught. After carefully reviewing this statement, examiner views argument is not what is being claimed. The portion of claim 1 reads: *print user designation managing means which creates a user ID and a password and a directory for a mail address used by said user, and transmitting said user ID and said password to said mail address.*

Examiner does not see the claim explaining or suggesting a response to a receipt of an email. Rather the examiner views the claim as explaining a creation of user ID and password for a particular mail address which is used by a user. Wantababe teaches the creation of a user Id and password which can be transmitted to an email address (please refer Wantabe column 7 lines 29-36). The claim also states *transmitting said user ID and said password to said mail address.* For this portion Fujii is brought in to show that emails with attachments can be sent to any number of users. Fujii explains the sharing of user ID and password with email addressed to friends. It would be understood that this notice mail can be sent to any user. You can include you're own name if you choose to. Further the claim does not specify where the user ID and password is being transmitted from.

Examiner would also like to point out for claim 11 and 12 Iwase does explain a printing device system that includes transmitting the user ID. Please refer to Iwase paragraph 117, 118 and 132.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Smarth whose telephone number is (571)270-1923. The examiner can normally be reached on Monday-Friday(7:30am-5:00pm)est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Pwu can be reached on (571)272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GERALD SMARTH/

Examiner, Art Unit 2446

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2446